| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/821,996 | 04/29/2004 | Damien Kessler | 07095.0040-01 | 1584 |

22852        7590        10/10/2007
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

| EXAMINER |
|---|
| MONTOYA, OSCHTA I |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2623 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 10/10/2007 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**.        2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) <u>29 and 30</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>29 and 30</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *  c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

## DETAILED ACTION

### *Double Patenting*

1.     The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees.   A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and  *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2.     Claim 29 is rejected on the ground of nonstatutory obviousness-type double

patenting as being unpatentable over claim 1 of U.S. Patent No. 6,741,288.  Although

the conflicting claims are not identical, they are not patentably distinct from each other

because they are different definitions or descriptions of the same subject matter varying

in breadth. For example, note the following relationship between the instant application

claim and the patented claim:

a) the preamble of application claim 29 "A method for maintaining a database in

memory of a digital television receiver for display of digital television broadcast signals

carried by a digital broadcast stream comprising system control data, the system control

data comprising first information relating to an ATSC broadcast standard and

also comprising second information relating to an MPEG-2 broadcast standard,

the method comprising" correspond to the "A method for maintaining a database for

display of digital television broadcast signals carried by a digital broadcast stream

including system control data, the system control data including first information relating

to a first broadcast standard and optionally also including second information

relating to a second broadcast standard, the method comprising" preamble of the

patented claim 1.


b) the claimed "receiving the digital broadcast stream" step of application claim 29

corresponds to the "receiving the digital broadcast stream" of patented claim 1;


c) the claimed "extracting the first information from the system control data" step

application of claim 29 corresponds to the "extracting the first information from the

system control data" of patented claim 1;


d) the claimed "storing a first set of data entries from the extracted first information" step

of application claim 29 corresponds to the "storing a first set of data entries from the

extracted first information" of patented claim 1;


e) the claimed "extracting the second information from the system control data" step of

application claim 29 corresponds to the "extracting the second information from the

system control data if the second information is present in the system control data" of

patented claim 1;

f) the claimed "storing a second set of data entries only if the extracted second

information is consistent with the first set of data entries" step of application claim 29

corresponds to the "storing a second set of data entries only if the extracted second

information is consistent with the first set of data entries" of patented claim 1.

It would have been obvious to one of ordinary skill in the art to readily recognize

that the conflicting claims are different definitions or descriptions of the same subject

matter varying in breadth. In this case, the method steps in application claim 29 and the

method steps of patented claim 1 perform the same function.

## *Claim Rejections - 35 USC § 102*

3.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.      Claim 29 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by
Klopfenstein, US 6,978,471.

Regarding claim 29, Klopfenstein discloses a method for maintaining a database
in memory of a digital television receiver for display of digital television broadcast
signals carried by a digital broadcast stream comprising system control data, the system
control data comprising first information relating to an ATSC broadcast standard and
also comprising second information relating to an MPEG-2 broadcast standard,
the method comprising:

receiving the digital broadcast stream (Col. 3, lines 64-67);

extracting the first information from the system control data (Col. 5, lines 63-67, Col. 6,
lines 1-2);

storing a first set of data entries from the extracted first information (Col. 5, lines 63-67,
Col. 7, lines 1-2);

extracting the second information from the system control data (Col. 6, lines 8-14); and

storing a second set of data entries only if the extracted second information is
consistent with the first set of data entries (Col. 6, lines 8-14).


Regarding claim 30, Klopfenstein discloses a method for maintaining a database
in memory of a digital television receiver for display of digital television broadcast
signals carried by a digital broadcast stream comprising system control data, the system
control data comprising first information relating to a first broadcast standard and
also comprising second information relating to a second broadcast standard, the

method comprising:

receiving the digital broadcast stream (Col. 3, lines 64-67);

extracting the first information from the system control data, the extracted information comprising a plurality of types of information having respective minimum quantities of information (plurality of type of information are the different entries of the tables , Col. 4, lines 22-59, Col. 5, lines 63-67, Col. 6, lines 1-2 );

storing a first set of data entries from the extracted first information (Col. 5, lines 63-67, Col. 6, lines 1-2), storing comprising:

creating a database entry for a first one of the types of information (PSIP table arrangement, Col. 4, lines 22-25); allocating a first portion of memory corresponding to the respective minimum quantity of information for the first one of the types (different entries on the table, Col. 4, lines 36-38); storing the database entry in the first portion of memory (each specific table is store in the database, Col. 4, lines 22-38); extracting additional first information for the database entry (additional entries are extracted until completing the tables, Col. 4, lines 22-38); allocating a second portion of memory, non-contiguous with the first portion (different tables, Col. 4, lines 22-38); and storing the additional first information in the second portion of memory (all these storing steps are well known and required in order to complete the tables or database, Col. 4, lines 22-59);

extracting the second information from the system control data (Col. 6, lines 8-14); and

storing a second set of data entries only if the extracted second information is consistent with the first set of data entries (Col. 6, lines 8-14).

## Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oschta Montoya whose telephone number is (571) 270-1192. The examiner can normally be reached on Monday/Friday 7:30 to 5:00 off every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OM

CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600